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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,784	11/21/2000	Heli Heiskari	944-003.040	8542

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EXAMINER

NGUYEN, LE V

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,784

Applicant(s)

HEISKARI, HELI

Examiner

Le Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to Amendment A, filed 9/24/03.
2. Claims 1-12 are pending in this application. This action is made Final.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4. Claims 1-2, 5-6 and 9-10 are rejected under 35 U.S.C. 102(b) as being unpatentable by Smith et al. ("Smith", US 5,923,327).

As per claim 1, Smith teaches a computer-readable medium encoded with a data structure for use in providing a graphical icon for display on a display of a portable communications device, characterized in that the data structure is encoded as digital data indicative of the graphical icon defined by alternating light and dark stripes, that selected stripes of the light and dark stripes change from light to dark and back to light to indicate a shadow adjacent an edge of the icon and from dark to light and back to dark to indicate a highlight adjacent another edge of the icon, and that altogether the light and dark stripes with shadows and highlight provide the icon with a three dimensional appearance (fig. 10; col. 7, line 43 through col. 8, line 6; *users may edit the bits of an icon bitmap*).

As per claim 2, Smith teaches a computer-readable medium characterized in that the data structure is encoded according to a portable bitmap file format (col. 7, line 61).

Claims 5 and 9 are individually similar in scope to claim 1 and are therefore rejected under similar rationale.

Claims 6 and 10 are individually similar in scope to claim 2 and are therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

5. Claims 3-4, 7-8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. ("Smith", US 5,923,327) in view of Hess et al. ("Hess", US 6,415,320 B1).

As per claims 3 and 4, Smith teaches a computer-readable medium characterized in that the data structure is encoded according to a Portable Bitmap file format (col. 7, line 61). Although Smith does not explicitly disclose the file format to be in a Portable Greymap file format or a portable color image file format/Portable Pixmap, Hess teaches a computer-readable medium characterized in that the data structure is encoded in various file formats, including Portable Bitmap file format, Portable Greymap file format and a Portable Pixmap (col. 8, lines 31-47; *PBM/PGM/PPM*). Therefore, it would have been obvious to an artisan at the time of the invention to include Hess' teaching of a computer-readable medium characterized in that the data structure is encoded in various file formats, including Portable Bitmap file format, Portable Greymap file format and a Portable Pixmap to Smith's teaching of a computer-readable medium characterized in that the data structure is encoded according to a Portable Bitmap file format in order to contribute to the flexibility of saving images in various file formats and providing an additional convenience to the users, especially given that all of these file formats are art equivalents.

Claims 7 and 8 in combination is similar in scope to the combination of claims 3 and 4 and is therefore rejected under similar rationale.

Claims 11 and 12 in combination is similar in scope to the combination of claims 3 and 4 and is therefore rejected under similar rationale.

Response to Arguments

6. Applicant's arguments filed in Amendment A have been fully considered but they are not persuasive.

Applicant argued the following:

(a) Smith does not describe, mention or even hint at anything about dark or light stripes in a graphical icon, resulting in the graphical icon not having a three-dimensional appearance as a result of this combination of light and dark stripes.

(b) There is no motivation to combine the references of Smith and Hess that there must be a reasonable expectation of success for combining these references.

(c) It is highly unlikely that somebody of ordinary skill in the art would have been reasonably expected to find the solution claimed by the Applicant without the benefit of hindsight.

The Examiner disagrees for the following reasons:

Per (a), the figure 10 as referred by the Office Action clearly depicts an icon with dark and light stripes (fig. 10; *i.e. the leftmost and first column of icon 1014, depicts an initial light stripe, followed by a dark stripe, followed by a light stripe*). Furthermore, consistent with the definition of three-dimensional as having or appearing to have extension in depth, icon 1014

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does indeed have a three-dimensional appearance (fig. 10; *the image of the house is in bold, giving it a raised look and therefore depth*), a resultant of the combination of light and dark stripes.

Per (b), in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Smith and Hess teach a computer-readable medium characterized in that the data structure is encoded in various file formats... Smith's file format is saved in Portable Bitmap, while Hess' file format is saved in Portable Bitmap file format, Portable Greymap file format and Portable Pixmap. In regards to the issue of whether combining Smith and Hess would result in success, both Smith and Hess teach a computer-readable medium characterized in that the data structure is encoded according to a Portable Greymap file format and Hess extends the teaching to include a Portable Bitmap file format and a Portable Greymap file format. The Examiner combined Hess' teaching with that of Smith, since these formats are considered art equivalents as is indicative of Hess' teaching that his invention may be implemented using any of these file formats.

Per (c), Portable Greymap file format and portable color image file format/Portable Pixmap would have been very well known to someone of ordinary skills in the art at the time of the invention as additional methods of saving images, especially since they are considered art

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equivalents to someone of ordinary skills in the art. Moreover, Applicant cites on page 6 of the specification that “the data structure may be stored in...a portable bitmap file format known in the art as [PBM]”, making it obvious that for pbm to be “known in the art”, portable bitmap file format must be known in the art also; since, the former is an acronym for the later.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquires

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lê Nguyen whose telephone number is (703) 305-7601. The examiner can normally be reached on Monday - Friday from 5:30 am to 2:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

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The fax numbers for the organization where this application or proceeding is assigned are as follows:


(703) 746-7238 [After Final Communication]

(703) 872-9306 [Official Communication]

(703) 746-7240 [For status inquiries, Draft Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Lê Nguyen
Patent Examiner
December 23, 2003



SY D. LUU
PRIMARY EXAMINER